

Fig. 18 ("AAPA Fig. 18"); and rejected claims 23 – 33 under 35 U.S.C. § 103(a) as unpatentable over Kondo and AAPA Fig. 18, and further in view of Kono (U.S. Patent No. 5,929,722).

Regarding the objection to drawings:

Regarding the drawings, Applicants propose amending Figs. 18 and 19, to add the legend "PRIOR ART," required by the Examiner, as shown in the attached Request for Approval of Drawing Changes. Applicants have amended Figs. 18 and 19. Upon approval of the proposed changes, Applicants respectfully request that the submission of formal revised drawings be deferred until after issuance of a Notice of Allowance.

Regarding the rejection of claims 18 – 22 and 34 – 36 under 35 U.S.C. § 103(a):

Applicants respectfully traverse the rejection of claims 18 – 22 and 34 – 36 under 35 U.S.C. § 103(a) as unpatentable over Kondo in view of AAPA Fig. 18. Applicants respectfully disagree with the Examiner's arguments and conclusions, and respectfully submit that a *prima facie* case of obviousness has not been established.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.03, 8th Ed., Aug. 2001, p. 2100-126, quoting *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference

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teachings. Third, there must be a reasonable expectation of success. *See* M.P.E.P. § 2143, pp. 2100-122 127.

The Examiner does not show that all the elements of Applicants' claims are met in the cited references, taken alone or in combination, does not show that there is any suggestion or motivation to modify the cited references to result in the claimed invention, and does not show there would be any reasonable expectation of success from so doing.

Applicants' independent claim 18 recites, *inter alia*: "a second transmission line magnetically coupled to said first transmission line, said first and second transmission lines being formed in said laminate." Kondo and AAPA Fig. 18, taken alone or in combination, do not teach or suggest at least this element of Applicants' independent claim 18.

The Examiner admits Kondo's deficiencies, in that "the reference does not show two magnetically coupled transmission lines in the substrate of the load capacitors" (Office Action, p. 3). Thus, this prior art reference does not teach or suggest all of Applicants' claimed elements.

In an attempt to cure Kondo's deficiencies, the Examiner alleges "[a]s noted in AAPA figure 18, APC signal is provided by a coupler (i.e. magnetically coupled transmission lines)." *Id.* According to AAPA Fig. 18, however, a terminal amplifier 1 provides a signal to non-reciprocal circuit device (isolator) 3 through directional coupler 2. Directional coupler 2 ensures that output proportional to the high frequency signal is moderated by automatic gain control circuit 7. Moreover, AAPA Fig. 18 does not disclose magnetically coupled transmission lines in directional coupler 2.

Even if the Examiner's characterization of AAPA Fig. 18 (*See* Office Action, p. 3) were correct, this still does not establish any requisite suggestion or motivation to modify either

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Kondo or AAPA Fig. 18 to produce Applicants' claimed invention. Applicants respectfully point out to the Examiner that it "is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *See In re Wesslau*, 147 U.S.P.Q. 391 (C.C.P.A. 1965), emphasis added. *See also* M.P.E.P. § 2141.02, p. 2100-120.

The M.P.E.P. also sets forth:

"However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)." M.P.E.P. § 2144.04, p. 2100-133.

As such, the present invention, as recited in independent claim 18, cannot be attained based merely on the combination of Kondo and AAPA Fig. 18. One skilled in the art would only arrive at the present claimed invention by consulting Applicants' disclosure. Therefore, the only way to construct the claimed invention from the cited references would be to rely on aspects related to the present invention. Such reliance, however, would constitute improper hindsight reasoning. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01, p. 2100-124, citing *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, Applicants submit that Kondo and AAPA Fig. 18, taken alone or in combination, do not suggest the desirability of any modification to result in Applicants' claimed

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invention, and these references do not show that there would be any reasonable expectation of success from so doing.

In addition, regarding reasonable expectation of success, as evidenced from Kondo's disclosure, it is "an object of [Kondo] to provide an isolator device with a built-in power amplifier making it possible to greatly decrease a high frequency output stage in size and thickness" (Kondo, ¶ [0010]). Kondo admits, however, that "[s]ince the high frequency output stage is united with the single dielectric multi-layered substrate, it is possible to greatly decrease the high frequency output state in size and thickness. Also, it is possible to reduce the number of components due to the unification" (Kondo, ¶ [0013]). Applicants submit that there is no reasonable expectation of success from modifying Kondo with AAPA Fig. 18, as this would serve to increase the number of components in Kondo, and therefore run contrary to Kondo's aim at reducing the number of components.

The Examiner improperly alleges that "[i]t would have been obvious ... to have substituted a coupler [into Kondo] ..." (Office Action, p. 3). Applicants submit that the Examiner has overlooked the differences between the present invention and the combination of Kondo and AAPA Fig. 18, and the impropriety of their combination. The M.P.E.P. states

"[a] statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the invention was made"" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." M.P.E.P. § 2143.01, p. 2100-124 (citations omitted, emphasis in original).

Applicants have already established that Kondo and AAPA Fig. 18, taken alone or in combination, do not teach or suggest Applicants' claimed invention, and submit that, according

to the M.P.E.P., the Examiner's reliance on Kondo and AAPA Fig. 18 is not sufficient to establish *prima facie* obviousness.

In developing the 35 U.S.C. § 103(a) rejection of Applicants' claims, the Examiner chose two references in combination, because each reference alone does not teach or suggest at least Applicants' claimed "second transmission line magnetically coupled to said first transmission line, said first and second transmission lines being formed in said laminate." (Applicants' independent claim 18). Applicants point out that, for the reasons already argued herein, the 35 U.S.C. § 103(a) rejection is improper, as Kondo and AAPA Fig. 18 do not teach or suggest at least each and every element of Applicants' independent claim 18. Adding AAPA Fig. 18 to Kondo, or vice versa, still does not teach or suggest every element of Applicants' independent claim 18, as quoted above. The Examiner instead attempted to compensate for the deficiencies of the cited references with speculative conclusions of "[i]t would have been obvious to..." (Office Action, p. 3). Applicants submit that the rejection is improper, and note that the rejection "should be stated with a full development of reasons rather than by a mere conclusions coupled with some stereotyped expression." *Id.*

In summary, the Examiner has therefore not met the essential criteria for establishing a *prima facie* case of obviousness. Applicants have demonstrated above that the Examiner: (a) has not shown all recitations of Applicants' claimed invention are taught or suggested by Kondo or AAPA Fig. 18; (b) has not shown any requisite motivation to modify Kondo or AAPA Fig. 18 to produce Applicants' claimed invention; and (c) has not shown there would be any reasonable expectation of success from modifying Kondo or AAPA Fig. 18 in order to produce the present claimed invention. Thus, Applicants submit that the Examiner's reliance on Kondo and AAPA Fig. 18 fails to establish *prima facie* obviousness.

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Regarding independent claims 20 and 22, Applicants submit that the Examiner has failed to establish *prima facie* obviousness for the reasons argued above regarding independent claim 18. *In addition*, Applicants note that Kondo and AAPA Fig. 18, taken alone or in combination, do not teach or suggest additional elements present in independent claims 20 and 22, namely “the conductor layers of said plural load capacitors on the hot side and the ground side being divided for every load capacitor” (Applicants’ independent claim 20) and “one of said load capacitors is electrically connected to said first transmission line via said central conductors, while the other load capacitors are not connected to said first transmission line” (Applicants’ independent claim 22).

Finally, regarding dependent claims 19, 21, and 34 – 36,

“Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were present as one independent claim.” M.P.E.P.

§ 608.01(n)(III), p. 600-77. “If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” M.P.E.P. § 2143.03, p. 2100-26.

Therefore, Applicants submit that independent claims 18, 20, and 22 are allowable, for the reasons already argued above. In addition, dependent claims 19, 21, and 34 – 36 are also allowable at least by virtue of their respective dependency from allowable base claims 18, 20, and 22. Therefore, Applicants respectfully submit that the Examiner should withdraw the 35 U.S.C. § 103(a) rejection.

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Regarding the rejection of claims 23 – 33 under 35 U.S.C. § 103(a):

Applicants respectfully traverse the rejection of claims 23 – 33 under 35 U.S.C. § 103(a) as unpatentable over Kondo and AAPA Fig. 18, and further in view of Kono. Applicants respectfully disagree with the Examiner's arguments and conclusions, and respectfully submit that a *prima facie* case of obviousness has not been established regarding dependent claims 23 – 33.

Applicants have already demonstrated conclusively in the previous section above that Kondo and AAPA Fig. 18, taken alone or in combination, do not teach or suggest all the recitations of Applicants' independent claims. The Examiner's addition of Kono, however, still does not teach or suggest the recitations not taught or suggested by Kondo and AAPA Fig. 18 to satisfy all the elements of Applicants' independent claims, and consequently, Kono does not cure the deficiencies of either Kondo or AAPA Fig. 18.

Therefore, since Applicants have already established that Kondo and AAPA Fig. 18, taken alone or in combination, do not teach or suggest at least each and every element of Applicants' independent claims, since Kono does not teach or suggest the elements of Applicants' claimed invention not taught or suggested by either Kondo or AAPA Fig. 18, and since the Examiner admitted deficiencies regarding Kondo and AAPA Fig. 18 (Office Action, p. 4), the Examiner has therefore not met at least one of the essential criteria for establishing a *prima facie* case of obviousness, wherein "the prior art reference (or references when combined) must teach or suggest all the claim limitations." See M.P.E.P. §§ 2142, 2143, and 2143.03. Consequently a 35 U.S.C. § 103(a) rejection cannot be applied.

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Furthermore, dependent claims 23 – 33 are allowable at least by virtue of their respective dependency from allowable base claims 18, 20, and 22. Therefore, Applicants respectfully submit that the Examiner should withdraw the 35 U.S.C. § 103(a) rejection.

Conclusion:

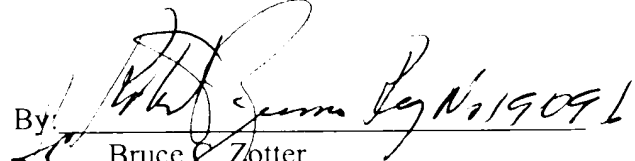
In view of the foregoing, Applicants request reconsideration of the application and submit that rejections detailed above are improper and should be withdrawn. Applicants submit that independent claims 18, 20, and 22 are in condition for allowance as are dependent claims 19, 21, and 23 – 36. A favorable action is requested.

Please grant any extensions of time under 37 C.F.R. § 1.136 required in entering this response. If there are any fees due under 37 C.F.R. § 1.16 or 1.17, which are not enclosed, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: January 21, 2003

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